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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,413	08/08/2001	Masanobu Seki	VX012332	9911

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VARNDELL & VARNDELL, PLLC
106-A S. COLUMBUS ST.
ALEXANDRIA, VA 22314

EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 03/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,413

Applicant(s)

Seki et al.

Examiner

Ljiljana V. Ciric

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 8, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug 8, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413), Paper No(s).
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6) ☐ Other:

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DETAILED ACTION

Response to Preliminary Amendments

1. Receipt and entry of the preliminary amendments filed on August 8, 2001 and on March 7, 2002 is hereby acknowledged.
2. The amendment filed on August 8, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the length of the connecting pipe 21 being longer than the spacing between the heat exchanger 14 and the relay blocks 15 plus the width of the sealing member 14 [as added to page 7]; the length of the connecting pipe 22 being longer than the spacing between the heat exchanger 12 and the relay blocks 18 plus the width of the sealing member 28 [as added to page 7]; the entire contents of the paragraph added after page 10 by the amendment; the length of the connecting pipe being longer than the sum of the distance between the temperature controlling heat exchanger and the second block added to a width of the sealing member [as cited in new claims 4 and 5]; and, the length of the first connecting pipe being longer than the sum of the distance between the temperature controlling heat exchanger and the second block added to the width of the first sealing member and the also being longer than the sum of the distance between the temperature controlled heat exchanger and the fourth block added to the width of the second sealing member [as cited in new claim 6].

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Applicant is required to cancel the new matter in the reply to this Office Action.

3. The amendment filed on March 7, 2002 is also objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows, for example: that the cooling water flowing in the cooling water passage may “be always renewed by new one or may be circulated with the outside” [as added to page 7]; and, the connecting pipe 21 or 22 having a length which is less than the distance between the edges of the respective heat exchanger and passage block to substantially equal but not exceeding 100% [as added to the paragraph after page 10]--note that this broadens the lower end of the range to include values less than the previous 80% of the distance while effectively changing the definition of the term “substantially equal” from “up to 105% of the distance” to “not exceeding 100% of the distance.”

Applicant is required to cancel the new matter in the reply to this Office Action.

4. Original claims 1 through 3 have been canceled and only new claims 4 through 6 remain in the application.

Oath/Declaration

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

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Non-initialed and/or non-dated alterations have been made to the oath or declaration. In particular, the date next to each signature has been altered without initialing the change. See 37 CFR 1.52(c).

Drawings

6. Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (as noted on page 6, line 4 of the specification). See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s): the length of the connecting pipe and the width of the sealing member as cited in each of claims 4 and 5; and, the respective lengths of the first and second connecting pipes and the respective widths of each of the first and second sealing members as cited in claim 6. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

8. The abstract of the disclosure is objected to because it contains numerous grammatical and idiomatic informalities and because the reference numerals appearing therein are not enclosed in

parenthesis. The abstract is also objected to because it does not avoid the legal phraseology often used in claims (i.e. "means"). Finally, the terminology appearing in the abstract is not consistent with that appearing in the claims (i.e., "sealing means" instead of "sealing member"). Correction is required. See MPEP § 608.01(b).

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: there is no antecedent basis in the specification for the term "sealing member" now appearing in the claims.

Claim Objections

10. Claim 4 is objected to because of the following informalities: "in the" [claim 4, line 10] should be replaced with "a". Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 4 through 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New claims 4 through 6 recite the length of the connecting pipe as being longer than the sum of the distance between the temperature controlling heat

exchanger and the second block added to a width of the sealing member, and, the length of the first connecting pipe as being longer than the sum of the distance between the temperature controlling heat exchanger and the second block added to the width of the first sealing member and the also being longer than the sum of the distance between the temperature controlled heat exchanger and the fourth block added to the width of the second sealing member. Since there is no support in the originally filed disclosure for these dimensional relationships as now recited in the claims, these dimensional relationships constitute new matter. The specification also fails to define the standard for ascertaining what range of values corresponds to the term "slightly shorter" as used in claims 4 through 6 to qualify the distance between the temperature controlling heat exchanger and the first block.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 4 through 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "slightly shorter" in each of claims 4 through 6 is a relative term which renders the claims indefinite. The term "slightly shorter" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Thus, as used to qualify the

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distance between the temperature controlling heat exchanger and the first block, this term renders this distance indefinite.

Also, the limitations following "wherein" in each of the claims are generally indefinite as written since they do not clearly correspond to any particular disclosed structure. For example, it is not clear what is encompassed by the "*a width* of said sealing member" as cited in claims 4 and 5, nor what is encompassed by "*a distance* between said temperature controlling heat exchanger and said first block" as also cited in claims 4 and 5. Claim 6 contains similar language and is similarly indefinite.

Claim Rejections - 35 U.S.C. § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. As best can be understood in view of the indefiniteness of the claims, claims 4 through 6 are rejected under 35 U.S.C. 102(b) as being anticipated by *Miller*.

Miller discloses the invention essentially as claimed, including, for example as shown in Figure 3 thereof: a connecting pipe corresponding to any one of tube 3' or a portion thereof; a first block 18 or 26'; a second block 10; and, a sealing member or o-ring 14. Tubes 3' are disposed in a temperature controlling heat exchanger.

The reference thus reads on the claims.

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Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Lauro, Denis, Hoffmüller, and Kertzman* each discloses a temperature control apparatus or heat exchanger including a combination of connecting pipes, blocks with passages therethrough, and sealing members.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett, can be reached on (703) 308-0101. The fax phone number is (703) 305-3463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

March 21, 2003



LJILJANA V. CIRIC
PRIMARY EXAMINER
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